



MS PETITION
Docket No.: 2091-0245P
(PATENT)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kazuo SHIOTA et al.

Application No.: 09/954,964

Confirmation No.: 9017

Filed: September 19, 2001

Art Unit: 3624

For: NETWORK PHOTOGRAPH SERVICE
SYSTEM

Examiner: D. S. Felten

RENEWED PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37

C.F.R. §1.181

HIGHER LEVEL OF REVIEW REQUESTED/
CONTINGENT PETITION TO REVIVE UNDER 37 C.F.R. §1.137

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the July 21, 2006 Decision on the Petition to Withdraw Holding of Abandonment (Notice of Abandonment mailed February 13, 2006), issued in connection with the above-identified application, this is a Renewed Petition to Withdraw Holding of Abandonment of the present application. Applicants respectfully request higher level review of this Renewed Petition. If this Renewed Petition is not favorably considered, Applicants hereby Petition for revival under 37 C.F.R. §§1.137(a) and/or (b).

Background

On July 15, 2005, the Examiner mailed a Request of Information under 37 C.F.R. §1.105, requiring Applicants to provide certain information that the Examiner asserted as being “reasonably necessary to the examination of the application.” In view of the fact that the subject application had already received four (4) substantive Office Actions, Applicants’ representative believed that this Request of Information under 37 C.F.R. §1.105 had been issued in error. After consulting with the Examiner, the Examiner’s Supervisor (Mr. Millin) orally confirmed to Applicants’ representative that the Request Under 37 C.F.R. §1.105 had indeed been issued in error and that it was not necessary for Applicants to respond to this Rule 105 Request. Thus, the Supervisory Patent Examiner decided to withdraw the Request Under 37 C.F.R. §1.105 within the statutory reply period.

There is no dispute that the Supervisory Patent Examiner responsible for this case expressly indicated to Applicants’ representative that the Request Under 37 C.F.R. §1.105 had indeed been issued in error and that Applicants were informed that it was not necessary to respond to this Rule 105 Request (i.e., the decision was made to withdraw the Request Under 37 C.F.R. §1.105). The attached Status Inquiry filed January 31, 2006 memorialized the fact that Mr. Millen confirmed that the Examiner would be mailing a new Office Action for the subject application, and that Applicants were not required to file a Reply to the Request dated July 15, 2005. See also the attached confirmation email from Mr. Millin dated November 4, 2005. Furthermore, Mr. Millin confirmed during a phone conversation in early March, 2006 that the Notice of Abandonment was mailed in error and that a new Office Action would be forthcoming.

Still further, Applicant’s representative further discussed this issue with Mr. Millin on August 3, 2006, during which Mr. Millin again reaffirmed that Applicants’ understanding was correct. Mr. Millin further conveyed that an Interview Summary had previously been prepared regarding this issue, but that for some reason the Interview Summary had not been reflected in the USPTO PAIR system. If the Office of Petitions has any doubt that the 37 C.F.R. §1.105 had indeed been issued in error and that Applicants were informed that it was not necessary to

respond to this Rule 105 Request (i.e., that the decision was made to withdraw the Request Under 37 C.F.R. §1.105), Applicants respectfully request that the Petitions Attorney discuss this issue with Mr. Millin (who has expressed his willingness to clarify this issue for the Office of Petitions).

Decision on Petition to Withdraw Holding of Abandonment

The July 21, 2006 Decision on Petition dismisses Applicants request to withdraw holding of abandonment, reasoning that:

Petitioner would have the Office withdraw the holding of abandonment based on the Supervisor's purported waiver of the need to respond to the Request for Information, but a rule cannot be waived via sending an email. The waiver of a rule is accomplished via obtaining a decision which grants a petition under 37 C.F.R. §183, and it does not appear that such a petition was ever filed. [Decision on Petition, pages 5-6].

Deficiencies in the Decision on Petition to Withdraw Holding of Abandonment

Applicants' respectfully submit that at least the above noted reasoning is deficient, in that it mischaracterizes the basis for Applicants' previous Petition to Withdraw Holding of Abandonment. Applicants have not asserted that an email served to waive Rule 105 (or any other rule). Instead, Applicants submitted an email exchange between Applicants' representative and the Supervisor in charge of this case as merely evidence to the undisputed and easily confirmable fact that Applicants were expressly informed that the Request Under 37 C.F.R. §1.105 had indeed been issued in error and that it was not necessary for Applicants to respond to this Rule 105 Request - i.e., that the U.S.P.T.O. decided to withdraw the Request Under 37 C.F.R. §1.105. The administrative task of updating the USPTO system to reflect that the Request Under 37 C.F.R. §1.105 was withdrawn is beyond the Applicants' control. Furthermore, Applicants

Representative had no reason to believe that a Petition to Suspend Rules under 37 C.F.R. §1.183 would be necessary to address the erroneous Request for Information Under 37 C.F.R. §1.105.¹

It is again requested that the abandonment status of the present application be immediately removed so that prosecution may resume.

Contingent Petition to Revive Abandoned Application Under 37 C.F.R. §§1.137(a) and/or (b)

If this renewed Petition to Withdraw Holding of Abandonment is not favorably considered, Applicants hereby Petition for revival under 37 C.F.R. §§1.137(a) and/or (b), in that any delay until the filing of this petition was unavoidable and/or unintentional, so that examination can resume on this application consistent with the Supervisory Patent Examiner's indication that the Request for Information under Rule 105 was erroneous and withdrawn.

Conclusion

If the U.S. Patent Examiner has any questions regarding the above matters, please contact Applicants' representative, D. Richard Anderson, at the phone number listed below.

It is submitted that no fees are required for filing this Petition, since the error occurred because of a mistake on the part of the U.S. Patent and Trademark Office.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any

¹ If necessary for favorable consideration of this Renewed Petition, Applicants certainly have no objection to the Office of Petitions considering this Renewed Petition (or any previous correspondence) as including, at least in part, a Petition to Suspend Rules under 37 C.F.R. §1.183.

additional fee, including any fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: August 15, 2006

Respectfully submitted,

By

D. Richard Anderson
Registration No.: 40,439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
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Suite 100 East
P.O. Box 747
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(703) 205-8000
Attorney for Applicant

Attachments: As indicated



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STATUS INQUIRY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

During a telephone conversation with SPE Vincent Millin on November 3, 2005, the Applicants' representative was notified that they did not need to file a reply to the Request for Information dated July 15, 2005, and that an Interview Summary would be faxed within the next week and a new Office Action would be issued. To date, Applicants' representative has not received any communication from the U.S. Patent and Trademark Office.

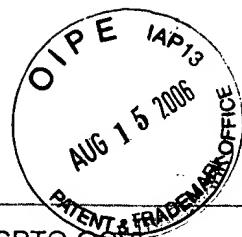
It is respectfully requested that the attorney named below be advised of the status of the above-identified application. Please advise us of when we might expect to receive an Office Action from the Patent and Trademark Office.

Dated: January 31, 2006

Respectfully submitted,

By _____

D. Richard Anderson
Registration No.: 40,439
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8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

**ANDERSON, D. Richard**

From: Millin, Vincent [Vincent.Millin@USPTO.GOV]
Sent: Friday, November 04, 2005 10:19 PM
To: ANDERSON, D. Richard
Subject: RE: US SER. No. 09/954,964
Importance: High

confirmed

-----Original Message-----

From: ANDERSON, D. Richard [mailto:DRA@bskb.com]
Sent: Friday, November 04, 2005 3:27 PM
To: Millin, Vincent
Subject: US SER. No. 09/954,964

Mr. Millin:

To memorialize our recent phone conversation, it is our understanding that the USPTO will be mailing out a new office action in place of the Rule 105 Request for Information dated July 15, 2005. Therefore, our client does not need to Reply to the July 15, 2005 Request. It is also our understanding that we will be receiving a fax within the next week or so to further confirm the status of this case.

Regards,

D. Richard Anderson
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